

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85711900
LAW OFFICE ASSIGNED	LAW OFFICE 102
MARK SECTION (no change)	
ARGUMENT(S)	
<p style="text-align: center;"><b>Request for Reconsideration</b></p> <p>This responds to the office action dated February 20, 2013.</p> <p>The refusal to register under Trademark Act Section 2(d) with respect to Registration No. 3,268,060 for the mark EXPECT THE BEST has been maintained, and the refusal has been made final. Applicant requests reconsideration of the refusal to register in light of the amendment to the description of services.</p> <p>The focus of Applicant's request for reconsideration lies with the likelihood of confusion factors relating to the alleged similarity of the services, as amended herein, between Applicant's mark and the services of the registered mark. Applicant maintains all its other arguments traversing the likelihood of confusion refusal stated in its communication of January 10, 2013, which are incorporated herein by reference.</p> <p style="text-align: center;"><b>Amendment to Services</b></p> <p>Applicant amends the description of services to the following:</p> <p style="padding-left: 40px;">Installation, maintenance and configuration of data centers and data security networks (Class 37) Computer services, namely design and consultation of data centers and data security networks (Class 42) Consultation in the field of security services, namely, providing security assessments of information systems, data centers and data security networks (Class 45)</p> <p>This description further and substantially distinguishes Applicant's services from the mechanical contractor services of the cited registration, as more fully explained below.</p> <p style="text-align: center;">Applicant's Services are Substantially Different From Services of Registered Mark</p> <p>The services under the registered mark are "mechanical contractor services". A mechanical contractor generally address a building's infrastructure and physical functioning capabilities. Applicant's services</p>	

have been amended and limited in scope to address "data centers and data security networks". Applicant's services, as amended, address systems controlling intangible matter that does not, in a direct sense, involve the building's infrastructure or physical functioning capabilities (such as HVAC, building automation or fire/security systems).

The Examiner indeed acknowledges that the respective services are not the same. He makes no argument that they are similar, but states that the respective services "need not be identical or even competitive to find likelihood of confusion".

### **The Respective Services Are Not So Related as to Cause Confusion**

Acknowledging that the respective services are dissimilar, the Examiner relies on the holding that "[A]bsent restrictions in an application and/or registration, the identified goods and/or services are presumed to travel in the same channels of trade to the same class of purchasers". However, the identified services in the registration are restricted in a way that does effectively limit the channels of trade and class of purchasers; they are restricted to "mechanical contractor services". The identification of services in the registration is particularly set forth through the use of the term "namely".

The terms "namely," "consisting of," "particularly," and "in particular" are definite and are preferred to set forth an identification that requires greater particularity. TMEP §1402.03(a)

The comparison of services in the likelihood of confusion analysis must focus on the goods/services as identified in the application and the cited registration. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 16 USPQ2d 1783 (Fed. Cir. 1990). Accordingly, the Examiner should not ascribe a greater breadth to the registration's services than what is particularly identified. Thus, the services under the registration are limited to mechanical contractor services, and specifically mechanical contracting services as they apply to installing and servicing of mechanical, HVAC, building automation, security and fire alarm systems. Applicant's services, as amended, are unrelated to those services.

### **Examiner's Evidence Does Not Support Claim That Services Are Sufficiently Related to Suggest Common Source of Origin**

The evidence cited by the Examiner does not establish or suggest a relationship between Applicant's services, as amended, with the mechanical contractor services of the registration to the extent that they would be considered related in the mind of the consuming public as to the origin of the services.

### **Class 37 Services**

Applicant's Class 37 services have been amended as follows:

- Installation, maintenance and configuration of data centers and data security networks

As discussed above, the services under the registration consist of mechanical contractor services, and do not extend to data centers or data security networks. None of the evidence cited by the Examiner establishes that mechanical contractor services are provided by a source that also offers installation, maintenance and configuration of data centers and data security networks. The Examiner's argument

that the respective services incorporate computer hardware, computers and networks into the design and installation glosses over the nature of today's technology, where practically everything is touched by computers in some way. As an example, telecommunication infrastructure also incorporates computer hardware, computers and networks, but one would not reasonably expect that mechanical contractor services and telecommunication services are related, or offered by the same source.

The respective technologies at issue here are physically dissimilar, and customers who would seek mechanical contractor services (i.e., those who are responsible for maintaining a building's infrastructure and physical operations) would likely be different than those seeking services to address their data centers and data security networks (i.e., those who are responsible for maintaining the organization's information technology operations). Even within an organization that would have need for both types of services, the personnel responsible for the respective duties would likely not deal with both. Therefore, there would be little occasion for a customer to use the same source for both activities. Accordingly, there should not be a reasonable belief on the part of customers that both types of services would generally originate from the same source.

#### Class 42 Services

Applicant's Class 42 services have been amended as follows:

- Computer services, namely design and consultation of data centers and data security networks

The services under the registration consist of installing and servicing mechanical contractor services. In contrast, Applicant's services under Class 42 involve designing and consulting services for data centers and data security networks. Designing and consulting would be expected to involve high-level involvement with the customer as opposed to the routine activities of installing and servicing of equipment which implies a low-level involvement with the customer. Similarly, a customer looking for the design and installation of data centers and data security networks would not be presumed to look to a source that merely installs and services mechanical systems. The Examiner's evidence does not establish that services comprising the design and installation of data centers and data security networks would be provided by the same source that installs and services mechanical systems. Accordingly, there should not be a reasonable belief that both types of services would generally originate from the same source.

#### Class 45 Services

Applicant's Class 45 services have been amended as follows:

- Consultation in the field of security services, namely, providing security assessments of information systems, data centers and data security networks

Applicant has restricted the identification of its services under Class 45 to consultation for providing security assessments of information systems, data centers and data security networks. In so doing, Applicant has made any perceived relationship between its Class 45 services to the specific activities of installation and servicing of mechanical systems even more attenuated. Mechanical contractor services would not be expected to reasonably factor in to a customer's criteria in seeking a source for providing sophisticated consultation services for data centers and data security networks. Moreover, the

Examiner's evidence does not reasonably suggest that such respective services would be offered through the same source. Accordingly, there should not be a reasonable belief that both types of services would generally originate from the same source.

### Conclusion

Applicant's services, as amended, are substantially dissimilar to those described in the cited registration. The Examiner has not provided substantial evidence that supports the proposition that the same customers would encounter the respective services and mistakenly believe that they are related and originate from the same source.

Applicant requests a favorable reconsideration and that the refusal to register be withdrawn.

### GOODS AND/OR SERVICES SECTION (037)(current)

INTERNATIONAL CLASS

037

#### DESCRIPTION

Installation, maintenance and configuration of computers and computer hardware networks, local networks, wide area networks, wireless networks, communication and collaboration networks, data centers, physical security networks, and data security networks

FILING BASIS

Section 1(a)

FIRST USE ANYWHERE DATE

At least as early as 01/31/2004

FIRST USE IN COMMERCE DATE

At least as early as 01/31/2004

### GOODS AND/OR SERVICES SECTION (037)(proposed)

INTERNATIONAL CLASS

037

#### TRACKED TEXT DESCRIPTION

~~Installation, maintenance and configuration of computers and computer hardware networks, local networks, wide area networks, wireless networks, communication and collaboration networks, data centers, physical security networks, and data security networks;~~ [Installation, maintenance and configuration of data centers and data security networks](#)

#### FINAL DESCRIPTION

Installation, maintenance and configuration of data centers and data security networks

FILING BASIS

Section 1(a)

FIRST USE ANYWHERE DATE

At least as early as 01/31/2004

FIRST USE IN COMMERCE DATE

At least as early as 01/31/2004

### GOODS AND/OR SERVICES SECTION (042)(current)

INTERNATIONAL CLASS

042

#### DESCRIPTION

Computer services, namely, design and consultation of computer networks, local networks, wide area networks, wireless networks, communication and collaboration networks, data centers, and data security

networks	
<b>FILING BASIS</b>	Section 1(a)
<b>FIRST USE ANYWHERE DATE</b>	At least as early as 01/31/2004
<b>FIRST USE IN COMMERCE DATE</b>	At least as early as 01/31/2004
<b>GOODS AND/OR SERVICES SECTION (042)(proposed)</b>	
<b>INTERNATIONAL CLASS</b>	042
<b>TRACKED TEXT DESCRIPTION</b>	
<del>Computer services, namely, design and consultation of computer networks, local networks, wide area networks, wireless networks, communication and collaboration networks, data centers, and data security networks;</del> <a href="#">Computer services, namely, design and consultation of data centers and data security networks</a>	
<b>FINAL DESCRIPTION</b>	
Computer services, namely, design and consultation of data centers and data security networks	
<b>FILING BASIS</b>	Section 1(a)
<b>FIRST USE ANYWHERE DATE</b>	At least as early as 01/31/2004
<b>FIRST USE IN COMMERCE DATE</b>	At least as early as 01/31/2004
<b>GOODS AND/OR SERVICES SECTION (045)(current)</b>	
<b>INTERNATIONAL CLASS</b>	045
<b>DESCRIPTION</b>	
Consultation in the field of security services, namely, providing security assessments of information systems, and working environments	
<b>FILING BASIS</b>	Section 1(a)
<b>FIRST USE ANYWHERE DATE</b>	At least as early as 01/31/2004
<b>FIRST USE IN COMMERCE DATE</b>	At least as early as 01/31/2004
<b>GOODS AND/OR SERVICES SECTION (045)(proposed)</b>	
<b>INTERNATIONAL CLASS</b>	045
<b>TRACKED TEXT DESCRIPTION</b>	
<del>Consultation in the field of security services, namely, providing security assessments of information systems, and working environments;</del> <a href="#">Consultation in the field of security services, namely, providing security assessments of information systems, data centers and data security networks</a>	
<b>FINAL DESCRIPTION</b>	
Consultation in the field of security services, namely, providing security assessments of information systems, data centers and data security networks	
<b>FILING BASIS</b>	

<b>FILING BASIS</b>	Section 1(a)
<b>FIRST USE ANYWHERE DATE</b>	At least as early as 01/31/2004
<b>FIRST USE IN COMMERCE DATE</b>	At least as early as 01/31/2004
<b>SIGNATURE SECTION</b>	
<b>RESPONSE SIGNATURE</b>	/glenn k. robbins ii/
<b>SIGNATORY'S NAME</b>	Glenn K. Robbins II
<b>SIGNATORY'S POSITION</b>	Attorney of Record, Missouri Bar Member
<b>SIGNATORY'S PHONE NUMBER</b>	314-863-7733
<b>DATE SIGNED</b>	08/09/2013
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	NO
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Fri Aug 09 17:06:45 EDT 2013
<b>TEAS STAMP</b>	USPTO/RFR-12.239.62.147-2 0130809170645633188-85711 900-50094b7f7edc46483d528 b29dcfef2a4e6ca9fbb99aece 34f05f4b3dd8918aa414-N/A- N/A-20130809152338138314

## Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **85711900** has been amended as follows:

### ARGUMENT(S)

**In response to the substantive refusal(s), please note the following:**

### Request for Reconsideration

This responds to the office action dated February 20, 2013.

The refusal to register under Trademark Act Section 2(d) with respect to Registration No. 3,268,060 for

the mark EXPECT THE BEST has been maintained, and the refusal has been made final. Applicant requests reconsideration of the refusal to register in light of the amendment to the description of services.

The focus of Applicant's request for reconsideration lies with the likelihood of confusion factors relating to the alleged similarity of the services, as amended herein, between Applicant's mark and the services of the registered mark. Applicant maintains all its other arguments traversing the likelihood of confusion refusal stated in its communication of January 10, 2013, which are incorporated herein by reference.

### **Amendment to Services**

Applicant amends the description of services to the following:

Installation, maintenance and configuration of data centers and data security networks (Class 37)  
Computer services, namely design and consultation of data centers and data security networks (Class 42)  
Consultation in the field of security services, namely, providing security assessments of information systems, data centers and data security networks (Class 45)

This description further and substantially distinguishes Applicant's services from the mechanical contractor services of the cited registration, as more fully explained below.

### **Applicant's Services are Substantially Different From Services of Registered Mark**

The services under the registered mark are "mechanical contractor services". A mechanical contractor generally address a building's infrastructure and physical functioning capabilities. Applicant's services have been amended and limited in scope to address "data centers and data security networks". Applicant's services, as amended, address systems controlling intangible matter that does not, in a direct sense, involve the building's infrastructure or physical functioning capabilities (such as HVAC, building automation or fire/security systems).

The Examiner indeed acknowledges that the respective services are not the same. He makes no argument that they are similar, but states that the respective services "need not be identical or even competitive to find likelihood of confusion".

### **The Respective Services Are Not So Related as to Cause Confusion**

Acknowledging that the respective services are dissimilar, the Examiner relies on the holding that "[A]bsent restrictions in an application and/or registration, the identified goods and/or services are presumed to travel in the same channels of trade to the same class of purchasers". However, the identified services in the registration are restricted in a way that does effectively limit the channels of trade and class of purchasers; they are restricted to "mechanical contractor services". The identification of services in the registration is particularly set forth through the use of the term "namely".

The terms "namely," "consisting of," "particularly," and "in particular" are definite and are preferred to set forth an identification that requires greater particularity. TMEP §1402.03(a)

The comparison of services in the likelihood of confusion analysis must focus on the goods/services as identified in the application and the cited registration. Octocom Systems, Inc. v. Houston Computers Services Inc., 16 USPQ2d 1783 (Fed. Cir. 1990). Accordingly, the Examiner should not ascribe a greater

breadth to the registration's services than what is particularly identified. Thus, the services under the registration are limited to mechanical contractor services, and specifically mechanical contracting services as they apply to installing and servicing of mechanical, HVAC, building automation, security and fire alarm systems. Applicant's services, as amended, are unrelated to those services.

### Examiner's Evidence Does Not Support Claim That Services Are Sufficiently Related to Suggest Common Source of Origin

The evidence cited by the Examiner does not establish or suggest a relationship between Applicant's services, as amended, with the mechanical contractor services of the registration to the extent that they would be considered related in the mind of the consuming public as to the origin of the services.

#### Class 37 Services

Applicant's Class 37 services have been amended as follows:

- Installation, maintenance and configuration of data centers and data security networks

As discussed above, the services under the registration consist of mechanical contractor services, and do not extend to data centers or data security networks. None of the evidence cited by the Examiner establishes that mechanical contractor services are provided by a source that also offers installation, maintenance and configuration of data centers and data security networks. The Examiner's argument that the respective services incorporate computer hardware, computers and networks into the design and installation glosses over the nature of today's technology, where practically everything is touched by computers in some way. As an example, telecommunication infrastructure also incorporates computer hardware, computers and networks, but one would not reasonably expect that mechanical contractor services and telecommunication services are related, or offered by the same source.

The respective technologies at issue here are physically dissimilar, and customers who would seek mechanical contractor services (i.e., those who are responsible for maintaining a building's infrastructure and physical operations) would likely be different than those seeking services to address their data centers and data security networks (i.e., those who are responsible for maintaining the organization's information technology operations). Even within an organization that would have need for both types of services, the personnel responsible for the respective duties would likely not deal with both. Therefore, there would be little occasion for a customer to use the same source for both activities. Accordingly, there should not be a reasonable belief on the part of customers that both types of services would generally originate from the same source.

#### Class 42 Services

Applicant's Class 42 services have been amended as follows:

- Computer services, namely design and consultation of data centers and data security networks

The services under the registration consist of installing and servicing mechanical contractor services. In contrast, Applicant's services under Class 42 involve designing and consulting services for data centers



and data security networks. Designing and consulting would be expected to involve high-level involvement with the customer as opposed to the routine activities of installing and servicing of equipment which implies a low-level involvement with the customer. Similarly, a customer looking for the design and installation of data centers and data security networks would not be presumed to look to a source that merely installs and services mechanical systems. The Examiner's evidence does not establish that services comprising the design and installation of data centers and data security networks would be provided by the same source that installs and services mechanical systems. Accordingly, there should not be a reasonable belief that both types of services would generally originate from the same source.

#### Class 45 Services

Applicant's Class 45 services have been amended as follows:

- Consultation in the field of security services, namely, providing security assessments of information systems, data centers and data security networks

Applicant has restricted the identification of its services under Class 45 to consultation for providing security assessments of information systems, data centers and data security networks. In so doing, Applicant has made any perceived relationship between its Class 45 services to the specific activities of installation and servicing of mechanical systems even more attenuated. Mechanical contractor services would not be expected to reasonably factor in to a customer's criteria in seeking a source for providing sophisticated consultation services for data centers and data security networks. Moreover, the Examiner's evidence does not reasonably suggest that such respective services would be offered through the same source. Accordingly, there should not be a reasonable belief that both types of services would generally originate from the same source.

#### **Conclusion**

Applicant's services, as amended, are substantially dissimilar to those described in the cited registration. The Examiner has not provided substantial evidence that supports the proposition that the same customers would encounter the respective services and mistakenly believe that they are related and originate from the same source.

Applicant requests a favorable reconsideration and that the refusal to register be withdrawn.

#### **CLASSIFICATION AND LISTING OF GOODS/SERVICES**

**Applicant proposes to amend the following class of goods/services in the application:**

**Current:** Class 037 for Installation, maintenance and configuration of computers and computer hardware networks, local networks, wide area networks, wireless networks, communication and collaboration networks, data centers, physical security networks, and data security networks

Original Filing Basis:

**Filing Basis: Section 1(a), Use in Commerce:** The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 01/31/2004 and first used in commerce at least as early as 01/31/2004, and is now in use in such commerce.

**Proposed:**

**Tracked Text Description:** ~~Installation, maintenance and configuration of computers and computer hardware networks, local networks, wide area networks, wireless networks, communication and collaboration networks, data centers, physical security networks, and data security networks;~~ Installation, maintenance and configuration of data centers and data security networks

Class 037 for Installation, maintenance and configuration of data centers and data security networks

**Filing Basis: Section 1(a), Use in Commerce:** The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 01/31/2004 and first used in commerce at least as early as 01/31/2004, and is now in use in such commerce.

**Applicant proposes to amend the following class of goods/services in the application:**

**Current:** Class 042 for Computer services, namely, design and consultation of computer networks, local networks, wide area networks, wireless networks, communication and collaboration networks, data centers, and data security networks

Original Filing Basis:

**Filing Basis: Section 1(a), Use in Commerce:** The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 01/31/2004 and first used in commerce at least as early as 01/31/2004, and is now in use in such commerce.

**Proposed:**

**Tracked Text Description:** ~~Computer services, namely, design and consultation of computer networks, local networks, wide area networks, wireless networks, communication and collaboration networks, data centers, and data security networks;~~ Computer services, namely, design and consultation of data centers and data security networks

Class 042 for Computer services, namely, design and consultation of data centers and data security networks

**Filing Basis: Section 1(a), Use in Commerce:** The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 01/31/2004 and first used in commerce at least as early as 01/31/2004, and is now in use in such commerce.

**Applicant proposes to amend the following class of goods/services in the application:**

**Current:** Class 045 for Consultation in the field of security services, namely, providing security assessments of information systems, and working environments

Original Filing Basis:

**Filing Basis: Section 1(a), Use in Commerce:** The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 01/31/2004 and first used in commerce at least as early as 01/31/2004, and is now in use in such commerce.

**Proposed:**

**Tracked Text Description:** ~~Consultation in the field of security services, namely, providing security assessments of information systems, and working environments;~~ Consultation in the field of security

[services, namely, providing security assessments of information systems, data centers and data security networks](#)

Class 045 for Consultation in the field of security services, namely, providing security assessments of information systems, data centers and data security networks

**Filing Basis: Section 1(a), Use in Commerce:** The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 01/31/2004 and first used in commerce at least as early as 01/31/2004, and is now in use in such commerce.

**SIGNATURE(S)**

**Request for Reconsideration Signature**

Signature: /glenn k. robbins ii/ Date: 08/09/2013

Signatory's Name: Glenn K. Robbins II

Signatory's Position: Attorney of Record, Missouri Bar Member

Signatory's Phone Number: 314-863-7733

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85711900

Internet Transmission Date: Fri Aug 09 17:06:45 EDT 2013

TEAS Stamp: USPTO/RFR-12.239.62.147-2013080917064563

3188-85711900-50094b7f7edc46483d528b29dc

fef2a4e6ca9fbb99aece34f05f4b3dd8918aa414

-N/A-N/A-20130809152338138314